

EXPEDITED PROCEDURE

R E M A R K S

A final Office Action was mailed on April 04, 2008. Claims 1 – 21 are pending; that claims 1 – 3, 5, 8 – 10, 12 – 14, 16, 17, 20 and 21 stand rejected under 35 U.S.C. §102; that claims 6, 7, 18 and 19 stand rejected under 35 U.S.C. §103; and that claim 15 is withdrawn from consideration.

Rejections under 35 U.S.C. §102

Claims 1 – 3, 5, 8 – 10, 12 – 14, 16, 17, 20 and 21 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the LexisNexis website printouts (hereinafter Lexis).

Rejections under 35 U.S.C. §103

Claims 6, 7, 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lexis in view of Shaw (“Inventing the ‘Paper’ of Figure...Newspapers and the Future: First of Two Part. Next: Fax, phones, fear and the future.” Los Angeles Times. June 2, 1991. Pages 1 – 8 hereinafter Shaw).

Claims 4 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lexis in view of Official Notice.

Response to Arguments

Applicants submit that at least for the following reasons, claims 1 – 3, 5, 8 – 10, 12 – 14, 16, 17, 20 and 21 are not anticipated by Lexis.

Applicants reiterate Applicants’ arguments set forth in Applicants’ responses filed on June 6, 2007, and October 23, 2007.

In addition, claim 1 requires:

“pre-defining one or more user-selectable limiting factors in a recommender system that limit optimal processing characteristics of a recommendation-generating process implemented in the recommender system”.

EXPEDITED PROCEDURE

In the Office Action, page 10, it is conceded by the Office that some of the factors disclosed in Lexis such as KWIC search, etc. are limiting the results after the results have already been processed. However, it is also stated that in Lexis, there are other factors regarding Jurisdiction selections that may be done prior to conducting a search in a database or may be done later as well; that a user can select sources such as state court cases, Federal and state case law, MO Supreme Court and Court of Appeals Cases, and only the selected source databases will be searched for the user provided query; and that these are therefore clearly optimal processing characteristics of a recommendation generating process. Applicants respectfully disagree.

Applicants submit that the Jurisdiction selections feature in Lexis is similar to having certain preferred search criteria or keywords stored in the user's profile, and these criteria or keywords are automatically pre-populated into each query. This is just a convenient feature so that the user does not have to enter the frequently used search criteria each time the user requests a search. Applicants submit that if the user has a search strategy that uses only certain selected databases, the user will have to make the database selection beforehand or at the time of the search, otherwise, the search strategy is not being followed and the desired search results will not be obtained. Once the search strategy is defined by the user, the queries and hence the results are the same for the case where the Jurisdiction selection was made beforehand using the Jurisdiction selections feature and the case where Jurisdiction selection was made at the time of the search. In the Office Action, it is argued that only the selected source databases will be searched for the user provided query; and that these are therefore clearly optimal processing characteristics of a recommendation generating process. However, Applicants would like to point out that the database selection is one of the search criteria. The Office is apparently comparing the processing of two different searches; one has search criterion on what databases to use, while the other does not have any limit on the databases. Therefore, the reason why there is a difference in the processing of the queries is because they are two different searches employing different search criteria. Applicants submit that the operational process by which the recommendation is generated is **not based on search criteria**, whether defined by the user beforehand or defined at the time of the search. Therefore, the Jurisdiction selection in Lexis

EXPEDITED PROCEDURE

does not teach “*pre-defining one or more user-selectable limiting factors in a recommender system that limit optimal processing characteristics of a recommendation-generating process implemented in the recommender system*” as claimed.

In view of the foregoing, Applicants submit that claim 1 is not anticipated by Lexis. Independent claims 14 and 17 contain similar feature as discussed above for claim 1, and therefore are not anticipated by Lexis. Claims 2 – 3, 5, 8 – 10, 12 – 13, and 20; 16; and 20 are also believed to be patentable because they depend from claims 1; 14; and 17 respectively. Withdrawal of the rejection of claims 1 – 3, 5, 8 – 10, 12 – 14, 16, 17, 20 and 21 under 35 U.S.C. § 102(a) is respectfully requested.

Applicants submit that the secondary reference Shaw does not bridge the above-discussed feature gap between Lexis and the claim 1 or 17. Therefore, claims 6 – 7 and 18 – 19 should also be patentable because they depend from claims 1 and 17 respectively. Applicants further submit that nothing in the Official Notice can bridge the above-discussed feature gap between Lexis and the claim 1. Therefore, claims 4 and 11 should be patentable because they depend from claim 1. Withdrawal of the rejection of claims 4, 6, 7, 11, 18, and 19 under 35 U.S.C. § 103(a) is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above remarks, it is believed that claims 1 – 14 and 16 – 21 are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Application Number: 09/902,407
Attorney Docket: US010319
Response to Office Action of April 04, 2008

EXPEDITED PROCEDURE

Any fee due with this paper, not already paid through an EFS-Web filing, may be charged to Deposit Account No. 50-3894. Any overpayment may be credited to Deposit Account No. 50-3894.

Respectfully submitted,

PHILIPS INTELLECTUAL PROPERTY & STANDARDS



By: Harris A. Wolin, Reg. No. 39,432
Attorney for the Applicant

Please Address All Correspondence to:

Michael Marion, Registration No. 32,266
Phone: (914) 333-9641
CUSTOMER NUMBER 24737